

REMARKS

This application has been carefully reviewed in light of the Office Action of April 1, 2008. Claims 49, 50, 52-61, and 63-71 are presented for examination, of which Claims 49, 60, and 71 are in independent form. Claims 49, 50, 52-61 and 63-71 have been amended to define Applicant's invention more clearly. Favorable reconsideration is respectfully requested.

Claims 49, 50, 52-61, and 63-71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Geiger* in view of *Aronson*. Applicant submits that independent Claims 49, 60, and 71, together with the claims dependent therefrom, are patentably distinct from the cited prior art for at least the following reasons.

Claim 49 relates to a communication apparatus which is connected to an E-mail server via a network. The communication apparatus includes a receiving unit, a first obtaining unit, a determining unit, and a sending unit. The receiving unit is adapted to receive from the E-mail server an E-mail which is to be sent to the communication apparatus, stored in a mail box provided on the E-mail server. The first obtaining unit is adapted to obtain size information from said E-mail server, the size information indicating a size of the E-mail stored in the mail box. The determining unit is adapted to determine whether or not to receive the E-mail stored in the mail box before said receiving unit receives the E-mail from the E-mail server, based on the size information obtained by the first obtaining unit. The sending unit is adapted to send a command to the E-mail server in order to receive the E-mail corresponding to the obtained size information if the determining unit determines to receive the E-mail. The receiving unit receives the E-mail, which is individually specified by the command sent by the sending unit, from the E-mail server, the E-mail being sent by the E-mail server in response to the command. The

sending unit does not send the command if the determining unit determines not to receive the E-mail. When the determining unit has determined not to receive the E-mail, the determining unit automatically proceeds to determine whether or not to receive an E-mail that is stored in the mail box and that is an E-mail other than the E-mail that the determining unit has determined not to receive.

Notable features of Claim 49 are the determining unit and the sending unit . By virtue of the features of the apparatus of Claim 49, a first obtaining unit obtains size information of an E-mail stored in an E-mail server, and a determining unit determines, based on the obtained size information, whether or not to receive the stored E-mail. If it is determined to receive the stored E-mail, a sending unit sends a command to the E-mail server so as to receive the stored E-mail corresponding to the obtained size information. Further, a receiving unit receives the E-mail which is individually specified by the command and was sent by the E-mail server in response to the sent command.

The Office Action concedes that *Geiger* does not teach or suggest that size information of an E-mail stored in an E-mail server is obtained from the E-mail server, and that a communication apparatus determines whether or not to receive the E-mail before receiving the E-mail from the E-mail server. Therefore, applying the same logic, Applicant also submits that nothing in *Geiger* is believed to teach or suggest the determining unit and the sending unit of Claim 49. That is, nothing has been found in *Geiger* by Applicant that teaches or suggest that as a result of a determination executed based on the obtained size information, if it is determined to receive the stored E-mail, a sending unit sends a command to the E-mail server so as to receive the stored E-mail corresponding to the obtained size information.

The Office Action, at page 4, argues that in *Aronson* a communication

apparatus discriminates, before receiving an E-mail from an E-mail server, whether or not to receive the E-mail. However, as understood by Applicant, in *Aronson*, before the E-mail is sent from the E-mail server to a client, a proxy server which received the E-mail from the E-mail server filters the relevant E-mail based on a preset filtering rule, and thus the client receives the filtered E-mail.

During the telephonic interview conducted on March 26, 2008, the Examiner argued that the “discriminating unit” of then-pending Claim 49 read on a conventional configuration of a proxy server from another device where e-mail filtering commands are sent to the proxy server (including filter rules relating to e-mail size) located between an e-mail server and a client device. Applicant continues to respectfully disagree with the Examiner’s reasoning and notes that, with respect to the language of the currently amended Claim 49, the command sent by the sending unit is quite different from the filtering command in *Aronson*. More particularly, the filtering command pointed out by the Examiner on page 4 of the Office Action is the command which is sent from the client device to the proxy server to notify the proxy server of the filtering rule before the process of filtering (corresponding to determination in the present invention) in the proxy server. However, the command in Claim 49 is sent according to a result of the determination executed based on the obtained size information. Moreover, the command in Claim 49 is to individually specify the E-mail corresponding to the obtained size information used in the determination, and to request, to the E-mail server, transmission of the E-mail individually specified by this command. That is, unlike Claim 49, the filtering command in *Aronson* pointed out by the Examiner merely indicates the filtering rule, but does not individually specifies an E-mail.

Therefore, the proposed combination of *Geiger* and *Aronson* does not teach

or suggest the features of Claim 49, and in particular fails to teach or suggest the determining unit and the sending unit of Claim 49. Therefore, the proposed combination of *Geiger* and *Aronson*, assuming such combination would even be permissible, is not believed to teach those features of Claim 49.

Accordingly, Claim 49 is believed patentable over *Geiger* and *Aronson*, whether considered separately or in any permissible combination (if any).

Independent Claims 60 and 71 include features similar to that discussed above with respect to Claim 49. Therefore, those claims are also believed to be patentable for at least the reasons discussed above.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

/Leonard P Diana/  
Leonard P. Diana  
Attorney for Applicant  
Registration No.: 29,296

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200

FCHS\_WS 2257939v1